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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/663,872	09/15/2000	J Michael Sanchez	D/A0664	4185

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EXAMINER

BAREFORD, KATHERINE A

ART UNIT	PAPER NUMBER
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1762

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Advisory Action**

Application No.

09/663,872

Applicant(s)

SANCHEZ ET AL.

Examiner

Katherine A. Bareford

Art Unit

1762

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 25 August 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

**PERIOD FOR REPLY** [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.
- ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search (see NOTE below);
  - (b) ☐ they raise the issue of new matter (see Note below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

3. ☐ Applicant's reply has overcome the following rejection(s): \_\_\_\_\_.
4. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: see attached pages.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☐ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: \_\_\_\_\_

Claim(s) objected to: \_\_\_\_\_

Claim(s) rejected: 1, 4-12, 15-21, 23 and 25-27.

Claim(s) withdrawn from consideration: \_\_\_\_\_

8. ☐ The proposed drawing correction filed on \_\_\_\_\_ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). \_\_\_\_\_
10. ☐ Other: \_\_\_\_\_

*Advisory Action*

1. Continuation of Box 5 of PTO-303 Advisory Action Form:

The Request for Reconsideration has been considered but does not place the case in condition for allowance because:

As to the rejection of claims 1, 4-7, 10, 12, 16-20 and 27 using Kawasaki in view of Hochberg, as discussed by the applicant on pages 2-3 of the Request for Reconsideration, the Examiner has reviewed the arguments raised by applicant, however the rejection is maintained. In the rejection the Examiner provided 6 features that were not explicitly taught by Kawasaki. The Examiner then provided the teachings of Hochberg, and reasoning as to why Kawasaki would be modified using Hochberg and knowledge generally available to one of ordinary skill in the art. The reasoning is provided in the Final Rejection. Applicant has provided no indication as to what is incorrect about the provided reasoning, other than that it could only be through the use of impermissible hindsight that the Examiner could reach a conclusion of obvious based on these six modifications and that the suggested modifications are "obvious to try" modifications, due to the fact that individual optimization of each suggestion is not obvious. However, the Examiner notes that there is no limitation as to the number of modifications that can be made, as long as these modifications would be obvious (the Examiner has provided the reasoning in the Final Rejection, as to why these modifications would be obvious). Furthermore, each modification does not apply to each claimed invention, since different features are missing from different claims. As to the argument that the suggested modifications are "obvious to try" modifications, due to the fact that individual optimization of each suggestion is not obvious, the Examiner disagrees. The Examiner

Art Unit: 1762

has provided reasoning as to why the suggested modifications should occur (in the Final Rejection) and applicant has provided no arguments as to why any of these specific suggestions would not provide for the desired modification or optimization.

As to the rejection of claims 8-9 and 15 using Kawasaki in view of Hochberg and EP 472 459 ('459), as discussed by the applicant on pages 3-4 of the Request for Reconsideration, the Examiner has reviewed the arguments raised by applicant, however the rejection is maintained. Applicant has argued that '459 is still not analogous art, because it would not have logically commended itself to the inventor's attention in considering his problem, because the problems associated with treating spent nuclear reactor fuel elements are not reasonably related to the problems in the imaging arts. However, the Examiner disagrees. '459 would not be in the field of applicant's endeavor. However, it is clearly related to the problem of providing unagglomerized particles in a stream using an ultrasonic treatment and providing a filtration at the end of the stream. The fact that nuclear fuel rods are not concerned with imaging does not mean that one of ordinary skill in the art would not look to them. One of ordinary skill would be expected to look beyond the imaging arts to other arts that are concerned with similar problems, and as shown by '459, the problem of providing unagglomerized particles in a stream is an issue that concerns many fields.

As to the rejection of claims 21, 23, 25 and 26 using Kawasaki in view of '459, as discussed by the applicant on page 4 of the Request for Reconsideration, the Examiner has reviewed the arguments raised by applicant, however the rejection is maintained. For the reasons given in the paragraph above, the Examiner maintains that '459 would be analogous art.

Art Unit: 1762

As to the rejection of claim 11 using Kawasaki in view of Hochberg and Min, as discussed by the applicant on pages 4-5 of the Request for Reconsideration, the Examiner has reviewed the arguments raised by applicant, however the rejection is maintained. Applicant has argued that Min is still not analogous art, because it would not have logically commended itself to the inventor's attention in considering his problem, because the problems associated with an apparatus in the paper art are not reasonably related to the problems in the imaging arts. However, the Examiner disagrees. Min would not be in the field of applicant's endeavor. However, it is clearly related to the problem of providing unagglomerized particles in a stream using an ultrasonic treatment and providing a filtration at the end of the stream. The fact that Min is not concerned with imaging does not mean that one of ordinary skill in the art would not look to them. One of ordinary skill would be expected to look beyond the imaging arts to other arts that are concerned with similar problems, and as shown by Min, the problem of providing unagglomerized particles in a stream is an issue that concerns many fields.

2. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Katherine A. Bareford whose telephone number is (703) 308-0078. The examiner can normally be reached on M-F(7:00-4:30) with the First Friday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P. Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

*Kath Bareford*  
KATHERINE A. BAREFORD  
PRIMARY EXAMINER  
GROUP 1100-1700